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AUG 30 2006

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WASHINGTON DC 20005

In re Application of
Proesch et al
Serial No.: 10/520,150
Filed: March 22, 2005
Attorney Docket No.: 2958-129

: PETITION DECISION

This is in response to the petition filed under 37 CFR 1.181 on May 22, 2006, requesting that claims 9-20 be examined in the present application. In addition, applicants petition that if claims 9-20 are not found to be encompassed by the invention, then applicants would like new claims 21-32 to be designated as encompassed by the elected invention.

BACKGROUND

A review of the file history shows that applicants filed a preliminary amendment on January 03, 2005, amending the claim multiple dependency but not the "use" language of the claims in accordance with US practice.

The examiner mailed a restriction requirement on June 14, 2005, clearly stating:-

> *In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.*
> *Claims 1-8, drawn to method of making a medicament using proteosome inhibitors.*
> *This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1 .*

The restriction was drawn to a method of making a medicament.

Applicants responded to the restriction on June 30, 2005, electing a species of the proteosome inhibitor without traversing and without amending the claims in accordance with US practice.

On August 10, 2005, the examiner mailed a non-final Office action wherein claims 1-5, drawn to the elected species, were rejected under 35 USC 101 and 35 USC 112, 2 paragraph. Claims 1-5 were also rejected under 35 USC 102 (b) over Weichold et al. Claims 6-8, drawn to the non-elected species, were withdrawn from consideration.

Applicants filed an amendment on February 7, 2006 canceling claims 1-5, withdrawing claims 6-8 and adding new claims 9-20 drawn to a method of treating a patient infected with a virus.

The examiner mailed a non-responsive letter on March 20, 2006 setting a response period of 30 days stating that newly added claims 9-20 were not readable on the elected invention because these claims are drawn to a method of treating a patient infected with a virus, whereas the previously examined and elected group of claims are drawn to a method of manufacture of a medicament for the treatment of an individual infected with a virus.

In response to the non-responsive letter, applicants filed this petition on May 22, 2006, along with an amendment adding new claims 21-32 and, requesting examination of claims 9-20 or claims 21-32.

DISCUSSION

Applicants argue that the claims were written as use claims because method of treatment claims are not permitted in Europe. However, in the preliminary amendment, applicants did not amend the "use" claims in accordance with standard US practice. In the response to the restriction, applicants elected without traverse, and at that time also failed to amend the claims according to US practice. The examiners' restriction clearly stated that the claims were drawn to a "method of manufacturing" and not a "method of treating". It was only after an action on the merits that applicants decided to amend the claims. Even though applicants amended the claims to a method of use format, they were drawn to a method of treating instead of a method of manufacturing. Thus, the examiner was correct in not examining new claims 9-20 drawn to a method of treating.

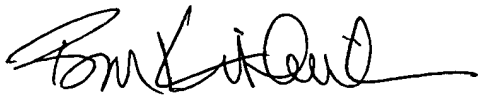
Also, in the amendment filed May 22, 2006, applicants added new claims 21-32 drawn to a method of preparing and administering a medicament for treating a virus selected from selected *proteosome inhibitors*. These claims are not drawn to the originally presented and elected invention in that they recite a "method of preparation and administration of a medicament" instead of a " method of manufacturing a medicament". A method of preparing and administrating a medicament is different than a method of manufacturing a medicament. One is drawn to a process of making formulations for administration and the other is drawn to a process of actually manufacturing (making) the medicament.

DECISION

In view of the above, the petition to examine new claims 9-20 or 21-32 is **DENIED.**

Any request for reconsideration of this petition decision must be filed within two (2) months of the mailing date of this decision.

Should there be any questions about this decision please contact Ms. Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number 571-273-8300.



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